REMARKS/ARGUMENTS

Claims 7-20 and 23-30 are pending. Reconsideration of this Application in light of the following remarks is respectfully requested.

35 U.S.C. §103 Rejections

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. *See* MPEP 2143. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). *See* MPEP 2143.03.

A. Claims 7-20 and 23-30 were rejected under 35 U.S.C. 103(a) as being unpatentable over Buirge in view of admissions in the present specification.

The Examiner's rejection of claims 7-20 and 23-30 under 35 U.S.C. 103(a) as being unpatentable over Buirge in view of admissions in the present specification is traversed because the Examiner has failed to establish a *prima facie* case of obviousness as required by MPEP §2143. The Applicant respectfully asserts that Buirge in view of alleged admissions in the present specification, alone or in combination, fails to disclose, teach, or suggest all the claim limitations of independent claims 7, 17, 23 and 24.

Specifically, Buirge in view of alleged admissions in the present specification, alone or in combination fails to teach or suggest a method for producing a stent that includes providing a preliminary stent comprising a permanent portion and a detachable portion, contacting an end of the detachable portion with at least one retainer; and retaining the preliminary stent with the at least one retainer solely at the end of the detachable portion, as recited in claim 7.

Buirge discloses a method of forming a three layer long tube on an elongated mandrel via a dip coating process where each layer of the tube is formed on the elongated mandrel by dipping the entire mandrel into a polymeric solution to coat the elongate mandrel with the stent forming solution. After the formed stent pump is hardened and dried, the laminate structure is removed from the mandrel by pulling out the core rod (mandrel) and pulling on the shrink tubing (see col. 4 lines 32-52). Thus, Buirge discloses a forming mandrel for use as a mold for forming the

stent-pump layer by layer. Merely teaching this method of forming a stent, Buirge does not, then, disclose providing a preliminary stent as claimed by the Applicant. Further, Buirge does not disclose a retainer that contacts solely the ends of a preliminary stent. Consequently, Buirge does not teach a method of producing a stent that includes the steps of providing a preliminary stent and retaining the preliminary stent with the at least one retainer solely at the end of the detachable portion, as recited in claim 7. Thus, Buirge does not teach each and every feature of claim 7. The alleged admissions alone or in combination with Buirge do not cure these defects.

Assuming, arguendo, that Buirge or the alleged admissions teach each and every element of independent claim 7 (which the Applicant does not concede), the substitution of the mandrel of Buirge with the retainer as suggested by the Examiner ("the mandrel is the retainer" see Final Office Action page 3) would not be made by one with ordinary skill in the art. The Examiner appears to allege that the substitution of the mandrel with the retainer is a simple substitution of one known element (mandrel) for another (retainer) to obtain predictable results (see *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1739, 82 USPQ2d 1385, 1395 (2007)). However, an understanding of the Buirge reference would clearly point out to one with skill in the art that this substitution would predictably result in failure. As noted above, the mandrel of Buirge is used as a mold to form the dipped stent, replacing this mandrel with at least one retainer that retains a preliminary stent solely at the ends would destroy the principle of operation of the Buirge reference as there would not be the required mandrel on which to form the stent.

For at least these reasons, claim 7 is patentable over Buirge in view of the alleged admissions. Claims 8-16 depend from independent claim 7 and include all of the elements and limitations of independent claim 1 and, thus, are allowable for at least the same reasons as those stated above for claim 7. For at least these reasons, the withdrawal of the rejection of claims 7-16 under 35 U.S.C. 103(a) is requested.

For similar reasons, Buirge in view of alleged admissions do not teach or suggest:

2) a system for producing a stent including means for providing a preliminary stent and means for retaining the preliminary stent solely by an end of the detachable portion, as recited in claim 17;

3) a stent coating system including a preliminary stent and a retainer, wherein the retainer contacts the preliminary stent solely at the first end and second end, as recited in claim 23; and

4) a preliminary stent coating system including at least one retainer; a preliminary stent wherein the at least one retainer contacts the preliminary stent solely at the detachable portion adjacent the retainer, as recited in claim 24.

Regarding independent claim 17, Buirge does not teach means for providing a preliminary stent and means for retaining the preliminary stent solely by an end of the detachable portion (see page 6 line 27 to page 7 line 14). As discussed above, Buirge merely discloses a forming mandrel for use as a mold for forming the entire stent-pump. Buirge does not, then, teach or suggest means for retaining the preliminary stent solely by an end of the detachable portion, as required by claim 17. The alleged admissions in the Applicant's specification do not cure these defects. Further as stated above, one with skill in the art would not make the substitution of the mandrel of Buirge with the means for retaining the preliminary stent solely by an end of the detachable portion as recited in claim 17. For at least these reasons, Buirge in view of the Applicant's specification do not teach or suggest all of the claim limitations of independent claim 17 or any claim depending therefrom. Claims 19-20 depend from claim 17 and include all of the limitations of that claim. For at least these reasons claims 19-20 are allowable over the Buirge patent in view of the Applicant's specification. Therefore, the withdrawal of the rejection of claims 17-20 under 35 U.S.C. 103(a) is requested.

Regarding independent claim 23, as discussed above, Buirge merely discloses a forming mandrel for use as a mold for forming the entire stent-pump. Buirge does not, then, teach or suggest a preliminary stent and a retainer for retaining the preliminary stent solely at the first end and second end of the detachable portions, as required by claim 23. The alleged admissions in the Applicant's specification do not cure these defects. Furthermore, as stated above, one with skill in the art would not make the substitution of the mandrel of Buirge with the retainer for retaining the preliminary stent solely at the first end and second end of the detachable portions as recited in claim 23. For at least these reasons, the withdrawal of the rejection of claim 23 under 35 U.S.C. 103(a) is requested.

Regarding independent claim 24, as discussed above, Buirge merely discloses a forming mandrel for use as a mold for forming the entire stent-pump. Buirge does not, then, teach or suggest a preliminary stent and at least one retainer for retaining the preliminary stent solely at the detachable portion adjacent the retainer, as required by claim 24. The alleged admissions in the Applicant's specification do not cure these defects. Additionally, as stated above, one with

skill in the art would not make the substitution of the mandrel of Buirge with the retainer for retaining the preliminary stent solely at the first end and second end of the detachable portions as recited in claim 24. Claims 25-30 depend from claim 24 and include all of the limitations of that claim. For at least this reason claims 25-30 are allowable over the Buirge patent. For at least these reasons, the withdrawal of the rejection of claims 24-30 under 35 U.S.C. 103(a) is requested.

B. Claims 8 and 18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Buirge in view of Wang (US 6379379)

Claim 8 depends from independent claim 7 and includes all of the elements and limitations of independent claim 7 and, thus, is allowable for at least the same reasons as those stated above for claim 7. Claim 18 depends from independent claim 17 and includes all of the elements and limitations of independent claim 17 and, thus, is allowable for at least the same reasons as those stated above for claim 17. Furthermore, where an independent claim is non-obvious, any claim depending therefrom is also non-obvious. *See*, MPEP 2143. Applicant, therefore, requests the withdrawal of the rejection of dependent claims 8 and 18 under § 103(a).

Conclusion

For the foregoing reasons, Applicant believes all the pending claims are in condition for allowance and should be passed to issue. The Commissioner is hereby authorized to charge any additional fees which may be required under 37 C.F.R. 1.17, or credit any overpayment, to Deposit Account No. 01-2525. If the Examiner feels that a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned at telephone (707) 543-5021.

Respectfully submitted,

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